

REMARKS/ARGUMENTS

Claims 13, 17, 20-25 and 27-33 are present in this application. By this Amendment, claims 13, 17 and 20-25 have been amended, claims 27-33 have been added, and claims 12, 14-16, 18, 19 and 26 have been canceled. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claim 26 was rejected under 35 U.S.C. §101. Applicant submits that this rejection is moot in view of the cancellation of claim 26. Withdrawal of the rejection is requested.

Claims 21, 23, 25 and 26 were rejected under 35 U.S.C. §112, second paragraph. By this Amendment, claims 21, 23 and 25 have been amended to more clearly satisfy the requirements of 35 U.S.C. §112, second paragraph. Claim 26 has been canceled. Withdrawal of the rejection is requested.

Claims 12-26 were rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,356,432 to Rutkow et al. To the extent this rejection may be applicable to new independent claim 27 and the dependent claims therefrom, this rejection is respectfully traversed.

New claim 27 defines an implantable prosthesis for the repair of muscle wall defects. The prosthesis comprises a flexible plug of a surgically compatible mesh material. This plug is required to (1) have an elongate form and (2) comprise an external mesh material wall. The external mesh material wall has three projecting longitudinal ridges or bulges that provide the plug with a generally triangular cross-sectional shape. The plug further comprises an internal support for maintaining the shape of the external mesh material wall.

In the Rutkow device, there is no equivalent of the “external mesh material wall” having “three projecting longitudinal ridges or bulges which provide the plug with a generally triangular

cross-sectional shape.” Instead, as set out in line 1 of page 4 of the Office Action, the Rutkow plug has a generally conical shape.

Applicant submits that there would have been no motivation on the part of the ordinarily-skilled person to modify the generally conical plug (with a circular cross-sectional shape) to have three projecting longitudinal ridges or bulges to provide the plug with a generally triangular cross-sectional shape. The entire disclosure of Rutkow relates to conical mesh plugs - see lines 15-16 and 24 of column 1 of Rutkow. In addition, the generally conical form of the Rutkow plug is such as to enable it to be pushed into a herniated opening, and then to be compressed within that defect - see line 64 of column 1 - line 15 of column 2 of Rutkow. As explained in the passage between line 60 of column 2 and line 3 of column 3 of Rutkow, in being conical, the Rutkow plug is able to closely match the contour of the herniated opening when compressed within the defect, thereby minimizing the formation of gaps between the implant and the surrounding tissue which could potentially lead to recurrent herniation. The conical shape of the Rutkow plug is thus essential to meet Rutkow’s stated aims.

There would thus have been no benefit in the Rutkow plug being modified so as to have three projecting longitudinal ridges or bulges to provide the plug with a generally triangular cross-sectional shape. Because herniated openings do not have a generally triangular cross-sectional shape, modifying the Rutkow plug to have a generally triangular cross-sectional shape would inevitably lead to the formation of gaps between the implant and the surrounding tissue, increasing the risk of recurrent herniation and being directly contrary to the statement set out at lines 60-63 of column 2 of Rutkow.

In contrast, the construction claimed for the implantable prosthesis in independent claim 27 provides practical benefits. The implantable prosthesis of the present invention is particularly

advantageous in the repair of elongate muscle wall defects. Rather than needing to use a plurality of generally conical prostheses to enclose an elongate muscle wall defect, a single implantable prosthesis of the present invention may be used. As explained in the paragraph beginning line 4 of page 3 of the present application as originally filed, the use of a plurality of prior art prostheses is expensive and can lead to unnecessary manipulation during the closure procedure. As explained in the passages beginning at line 19 of page 2 and line 24 of page 4, the prosthesis of the present invention can be supplied as a stock (oversized) length, and the surgeon can then cut an appropriate sized length of material from the stock length piece so as to enable a single prosthesis of surgically compatible mesh material to be used to close an elongate muscle wall defect, such as an inguinal hernia defect.

Applicant thus respectfully submits that claim 27 is allowable over the Rutkow patent. As a consequence, Applicant also submits that the dependent claims are allowable at least by virtue of their dependency on an allowable independent claim.

Withdrawal of the rejection is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

BARKER
Appl. No. 10/542,142
January 12, 2009

Respectfully submitted,

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